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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,735	07/12/2001	William D. Suval	845642-1	5339

7590 10/21/2003  
O'MELVENY & MYERS LLP  
400 So. Hope Street  
Los Angeles, CA 90071-2899

EXAMINER

ROBERTS, PAUL A

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/905,735

Applicant(s)

SUVAL, WILLIAM D.

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,6 and 9-12 is/are allowed.
- 6) ☒ Claim(s) 1,5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the lumen" in line 4. There is insufficient antecedent basis for this limitation in the claim. Adding language to claim 1, such as "wherein said sheath catheter comprises a lumen" after "sheath catheter" in line 3 of claim 1, would obviate this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkins 5,970,982.

1. Regarding claim 1, the applicant's amendment required the Perkins reference to be reinterpreted, but the limitations of the amended claim 1 are still anticipated by Perkins. Specifically, Perkins discloses, a vessel harvesting device (10, figure 1a) comprising a stenting catheter (20), a sheath catheter (12) with proximal and distal ends (all catheters have such ends)

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and a cutting tube (26) that is connectable to the distal end of the sheath catheter (figure 1a shows all three tubes connected at the distal end.) The stenting catheter (20) is located within the lumen of the sheath catheter (12).

2. Regarding claim 5, a cutting tube is disclosed in lines 29-33, col. 2. The disclosure states that this is a sharp surface for cutting vessel tributaries. Thus the blade must have a sharpened surface, and since all sharpened blades are inherently beveled, Perkins discloses a beveled cutting blade on the device.

3. Regarding claim 7, the Perkins device comprises a vessel collecting lumen. Perkins does not specifically describe the vessel collecting lumen as part of the cutting tube. But it must be part of the cutting tube (lines 40-45, col. 7), since the lumen is inside the outer catheter.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins. The cutting tube and collecting tube must be long enough to fully capture a vein, and short enough to be manageable. Perkins does not disclose the length for the cutting tube nor the collecting lumen, nor does Perkins specify the length of the diameter of the cutting tube. However, the workable range of a vessel dissector ranges from greater than 0 cm to less than or equal to the length of the largest vein. The workable range of a vessel dissector's cutting tube diameter ranges from the smallest veins .05 mm to slightly greater than the width of the vena cava. The function of the Perkins device necessitates the structure of the device's parts to be within certain

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dimensions. Said dimensions are: cutting tube 5-20 cm long and 3-15mm in diameter, and collecting lumen 3-15 cm long. At the time of the invention it would have been obvious to one having ordinary skill in the art to build the Perkins device within certain dimensions to allow the device to be used for it's intended purpose of vessel resection, wherein said dimensions are cutting tube 5-20 cm long and 3-15mm in diameter, and collecting lumen 3-15 cm long.

***Allowable Subject Matter***

Claims 2, 3, 6, 9, 10, 11, and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

5. The prior art does not disclose the following:

- A peel away catheter
- Connecting prongs and ports
- Guide wires to navigate the device.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

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organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts

Paul.Roberts@uspto.gov

17/10/03



MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700